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10/710,814

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Craig S. Gravina

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EXAMINER

ALVESTEFFER, STEPHEN D

ART UNIT

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2173

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/710,814

Applicant(s)

GRAVINA ET AL.

Examiner

Stephen Alvesteffer

Art Unit

2173

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-37 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 August 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 04 August 2004
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____

DETAILED ACTION

Claims 1-37 are presented for examination. Claims 1, 29, 30, and 31 are independent claims.

The Information Disclosure Statements filed on December 30, 2004, February 11, 2005, February 14, 2005, July 21, 2005, August 19, 2005, September 9, 2005, January 13, 2006, February 13, 2006, and February 21, 2007 have been considered by the examiner.

The instant application is a continuation-in-part of PCT/US03/34989, filed November 3, 2003. The instant application is also a continuation-in-part of application number 10/605,868 filed November 1, 2003, which claims the benefit of provisional application number 60/423,161, filed on November 1, 2002. The instant application is further a continuation-in-part of application 10/605,870 filed November 2, 2003, which also claims the benefit of provisional application number 60/423,161, filed on November 1, 2002. Said PCT/US03/34989 is a continuation of said application 10/605,868. The instant application further claims the benefit of provisional applications 60/571,900, 60/571,706, 60/571,746, 60/571,784, 60/571,745, 60/571,902, and 60/571,750, all filed on May 17, 2004.

Claim Rejections - 35 USC § 102

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3, 5, 8-19, 21-26, 29-33, and 35-37 are rejected under 35 U.S.C. 102(e) as being anticipated by Kavanagh, United States Patent Application Publication number 2004/0054826.

Regarding claim 1, Kavanagh teaches a media presentation system, comprising, (a) a host system for presenting media content, said host system including a machine readable medium containing the media content (see Figure 1 and paragraph [0029]; "...directing playback of multimedia clips of DVD"), and (b) an apparatus for controlling presentation of the media content by said host system, said apparatus comprising, (i) a removable user interface (RUI) (see Figure 1 and paragraph [0022]; "a number of keys of keyboard 206 are also visually configurable by the use of plastic overlays which specify functions of overlaid keys in the context of the game represented by program 302"), (ii) a user input (see Figure 1 and paragraph [0022]; "Keyboard 206 (FIG. 2) is the primary user input device"), (iii) a controller, said RUI removably attached to said controller, said controller (see paragraph [0022]; "a number of keys of keyboard 206 are also visually configurable by the use of plastic overlays which specify functions of overlaid keys in the context of the game represented by program 302") comprising, (A) a processor (see paragraph [0015]; "game control unit 103 includes a general purpose processor"), (B) a program in machine readable medium executed by said processor that interprets machine executable instructions (see paragraph [0030]; "Game control unit 103 requires a one-time initialization process in which game control unit 103 is configured to emulate remote control signals"), and (iv) a machine readable medium having a library of machine executable instructions that are accessible to said

program for communicating to said host system, in a protocol of said host system, commands relating to presentation of the media content (Device Dependent Instructions) (see paragraph [0004]; *"memory card device contains both the computer instructions defining the behavior of the interactive program and a layout map of an associated DVD disk such that the portable computer device can select content of the associated DVD disk for presentation to the user"*), and (v) a controller-independent storage medium (CISM) comprising a machine readable medium containing machine executable instructions relating to media presentation (Device Independent Instructions), said CISM being a separate component from said controller (see paragraph [0004]; *"The interactive program is executed by the portable computer device from a memory card device"*, the memory card device is the same as the CISM), (c) wherein said program executed by said processor performs a method comprising the steps of, (i) in response to actuation of said user input, reading one or more of said Device Independent Instructions (see paragraph [0021]; *"Game control unit 103 detects insertion of memory device 104 into memory card reader 209 and reads code 302 (FIG. 3) and DVD map 301. CPU 201 (FIG. 2) commences execution of the code supplied on memory device 104. During such execution, CPU 201 (i) processes signals received by physical manipulation of keyboard 206 by the user"*, the memory card stores Device Independent Instructions), (ii) based on one or more of said read Device Independent Instructions, accessing one or more of said Device Dependent Instructions (see paragraph [0021]; *"Game control unit 103 detects insertion of memory device 104 into memory card reader 209 and reads code 302 (FIG. 3) and DVD map 301. CPU 201*

(FIG. 2) commences execution of the code supplied on memory device 104. During such execution, CPU 201 (i) processes signals received by physical manipulation of keyboard 206 by the user”, the host system itself executes Device Dependent Instructions), and (iii) based on said accessed machine executable instructions of said library, communicating one or more of said commands to said host system (see paragraph [0021]; “provides game play functionality such as timers, random number generation and scoring”).

Regarding claim 2, Kavanagh teaches that the Device Independent Instructions are specific to the media content presented by said host system (see paragraph [0020]; *“This data contains a code 302 (FIG. 3) and a DVD map 301 which are specific to DVD 106”, the code is specific to DVD, but is independent of the device).*

Regarding claim 3, Kavanagh teaches that said controller includes said user input (see paragraph [0022]; *“Keyboard 206 (FIG. 2) is the primary user input device of game control unit”).*

Regarding claim 5, Kavanagh teaches that said RUI comprises an overlay for placement over said controller, said overlay including thereon printed graphical indicia (see paragraph [0022]; *“a number of keys of keyboard 206 are also visually configurable by the use of plastic overlays which specify functions of overlaid keys in the context of the game represented by program 302”).*

Regarding claim 8, Kavanagh teaches that said machine readable medium of said CISM contains machine executable instructions for defining actuation zones, and wherein said user input is actuated by placement of said user input proximal one of the

actuation zones (see paragraph [0004]; *"This memory card device contains both the computer instructions defining the behavior of the interactive program and a layout map of an associated DVD disk such that the portable computer device can select content of the associated DVD disk for presentation to the user"*).

Regarding claim 9, Kavanagh teaches that said CISM comprises a cartridge, and said controller includes an interface for removably receiving said cartridge for reading of said Device Independent Instructions therefrom (see paragraph [0015]; *"it should be appreciated that other memory devices can be used to provide computer instruction for game control unit 103. Illustrative examples include ubiquitous flash memory devices such as compact flash cards, smart media cards, memory sticks, multimedia cards, secure digital cards, and USB portable memory "drives" as well as floppy disks, CDROMs in various sizes and shapes, and wireless and wired network connections to other computers"*, compact flash cards, smart media cards, and multimedia cards are types of cartridge).

Regarding claim 10, Kavanagh teaches that said CISM further comprises said machine readable medium having a library of machine executable instructions (see paragraph [0004]; *"memory card device contains both the computer instructions defining the behavior of the interactive program"*).

Regarding claim 11, Kavanagh teaches that said CISM further includes accompanying media content for presenting in conjunction with the presentation of the media content by the host system (see paragraph [0004]; *"The standard home entertainment equipment can be a standard digital video disk (DVD) player and a digital*

video disk which is authored to include rich audiovisual content for presentation under control of the portable computer device”).

Regarding claim 12, Kavanagh teaches that said controller further includes a media presentation component for presenting said accompanying media content (see paragraph [0004]; *“The standard home entertainment equipment can be a standard digital video disk (DVD) player and a digital video disk which is authored to include rich audiovisual content for presentation under control of the portable computer device”).*

Regarding claim 13, Kavanagh teaches that said media presentation component of said controller comprises a speaker (see paragraph [0004]; *“The standard home entertainment equipment can be a standard digital video disk (DVD) player and a digital video disk which is authored to include rich audiovisual content for presentation under control of the portable computer device”,* in order for audio content to be audible, a speaker must inherently be present).

Regarding claim 14, Kavanagh teaches that said controller further comprises said machine readable medium having a library of machine executable instructions (see paragraph [0015]; *“game control unit 103 includes a general purpose processor for executing computer instructions”).*

Regarding claim 15, Kavanagh teaches that said controller comprises an interface for removably receiving said machine readable medium having a library of machine executable instructions (see paragraph [0004]; *“memory card device contains both the computer instructions defining the behavior of the interactive program and a layout map of an associated DVD disk”).*

Regarding claim 16, Kavanagh teaches that said host system includes a DVD player, and said machine readable medium containing the media content presented by said host system comprises a DVD (see paragraph [0014]; *"a game control unit 103 (FIG. 1) uses existing multimedia infrastructure such as a conventional DVD player 101 for display of multimedia content in accordance with game logic stored on a memory device 104"*).

Regarding claim 17, Kavanagh teaches that said user input comprises multiple selectable user inputs each corresponding to particular said Device Independent Instructions (see paragraph [0022]; *"Keyboard 206 (FIG. 2) is the primary user input device of game control unit 103 and can mimic the main functions of a standard DVD remote control and additionally provides application-specific assignable keys as well as custom key operation"*).

Regarding claim 18, Kavanagh teaches that, (i) said user input comprises a position sensor disposed in electronic communication with said controller, and (ii) said user input is actuated by placement of a selector proximal the position sensor (see paragraph [0022]; *"Keyboard 206 (FIG. 2) is the primary user input device of game control unit 103 and can mimic the main functions of a standard DVD remote control and additionally provides application-specific assignable keys as well as custom key operation"*, a keyboard inherently must sense the position of a key-press to determine which key was pressed).

Regarding claim 19, Kavanagh teaches that said selector comprises a finger (see paragraph [0022]; *"Keyboard 206 (FIG. 2) is the primary user input device of game*

control unit 103 and can mimic the main functions of a standard DVD remote control and additionally provides application-specific assignable keys as well as custom key operation", a finger is the primary mode of actuating input on a keyboard).

Regarding claim 21, Kavanagh teaches that, (i) said position sensor comprises a plurality of pressure-sensitive switches, and (ii) said user input is actuated by said selector pressing at least one said pressure-sensitive switch (see paragraph [0022]; *"Keyboard 206 (FIG. 2) is the primary user input device of game control unit 103 and can mimic the main functions of a standard DVD remote control and additionally provides application-specific assignable keys as well as custom key operation"*, keyboards operate by sensing pressure on a key).

Regarding claim 22, Kavanagh teaches that, (i) said position sensor has an active range, and (ii) said user input is actuated by placement of said selector within said active range (see paragraph [0022]; *"Keyboard 206 (FIG. 2) is the primary user input device of game control unit 103 and can mimic the main functions of a standard DVD remote control and additionally provides application-specific assignable keys as well as custom key operation"*, the active range on a keyboard device is directly over each key).

Regarding claim 23, Kavanagh teaches that said RUI comprises said user input (see paragraph [0022]; *"Keyboard 206 (FIG. 2) is the primary user input device of game control unit 103 and can mimic the main functions of a standard DVD remote control and additionally provides application-specific assignable keys as well as custom key operation"*).

Regarding claim 24, Kavanagh teaches that said controller comprises said user input (see paragraph [0022]; *"Keyboard 206 (FIG. 2) is the primary user input device of game control unit 103 and can mimic the main functions of a standard DVD remote control and additionally provides application-specific assignable keys as well as custom key operation"*).

Regarding claim 25, Kavanagh teaches that, (i) said RUI comprises an overlay having graphical indicia representing said user input (ii) said user input is actuated through said overlay (see paragraph [0022]; *"a number of keys of keyboard 206 are also visually configurable by the use of plastic overlays which specify functions of overlaid keys in the context of the game represented by program 302"*).

Regarding claim 26, Kavanagh teaches that said user input is actuated through said overlay by placement of a selector proximal said graphical indicia (see paragraph [0022]; *"a number of keys of keyboard 206 are also visually configurable by the use of plastic overlays which specify functions of overlaid keys in the context of the game represented by program 302"*).

Claim 29 recites a system with substantially the same limitations as the system of claim 1. Therefore, claim 29 is rejected under the same rationale.

Claim 30 recites an apparatus with substantially the same limitations as the system of claim 1. Therefore, claim 30 is rejected under the same rationale.

Claim 31 recites a media package with substantially the same limitations as the system of claim 1. Therefore, claim 31 is rejected under the same rationale.

Claim 32 recites a media package with substantially the same limitations as the system of claim 16. Therefore, claim 32 is rejected under the same rationale.

Claim 33 recites a media package with substantially the same limitations as the system of claim 5. Therefore, claim 33 is rejected under the same rationale.

Claim 35-37 recite a media package with substantially the same limitations as the system of claim 9. Therefore, claims 35-37 are rejected under the same rationale.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kavanagh (2004/0054826) *supra* and Yap et al. (hereinafter Yap), United States Patent Application Publication number 2003/0023554.

Regarding claim 4, Kavanagh teaches all the elements of claim 4 except that said user input comprises a stylus disposed in electronic communication with said controller. However, Yap teaches the use of a stylus as an input device (see paragraph [0727]; "*sending of information relating to the pressing, moving and releasing of an object (typically a finger or stylus) on the touch panel 8 of the reader 1*"). It would have been obvious to one of ordinary skill in the art at the time the invention was made to

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include a stylus as taught by Yap with the invention of Kavanagh to provide additional input methods.

Regarding claim 20, Yap teaches that said selector comprises a stylus separate from the controller (see paragraph [0727]; *"sending of information relating to the pressing, moving and releasing of an object (typically a finger or stylus) on the touch panel 8 of the reader 1"*, the system is capable of having more than one input device, so the stylus input system could be separate from the keyboard input system).

Claims 6, 7, and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kavanagh (2004/0054826) *supra* and Harris et al. (hereinafter Harris), United States Patent Application Publication number 2001/0033243.

Regarding claim 6, Kavanagh teaches all the limitations of claim 6 except that said RUI comprises a book. Harris suggests that a "code book" is useful for a user of a reprogrammable remote control device (see paragraph [0009]; *"Entering identifier codes into a remote control can be time consuming and difficult for many users. If the user loses the "code book" that comes with the universal remote control they are often times left with a useless universal remote control that they are unable to reprogram"*). It would have been obvious to one of ordinary skill in the art at the time the invention was made to include a code book as in Harris with a changeable user interface device as in Kavanagh for the purpose of showing users the functions of reprogrammed buttons.

Regarding claim 7, Harris teaches that, (i) said RUI comprises a book having graphical indicia representing actuation zones (see paragraph [0009]; *"Entering identifier codes into a remote control can be time consuming and difficult for many users. If the user loses the "code book" that comes with the universal remote control they are often times left with a useless universal remote control that they are unable to reprogram"*), (ii) said user input comprises a stylus disposed in electronic communication with said controller (see paragraph [0060]; *"pointing devices such as a computer mouse, a jog switch 22, a track ball, a stylus, or a tablet to manipulate a pointer on a screen of the electronic system 100"*), and (iii) said user input is actuated by placement of said stylus proximal one of the actuation zones (see paragraph [0060]; *"pointing devices such as a computer mouse, a jog switch 22, a track ball, a stylus, or a tablet to manipulate a pointer on a screen of the electronic system 100"*).

Claim 34 recites a media package with substantially the same limitations as the system of claim 6. Therefore, claim 34 is rejected under the same rationale.

Claims 27 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kavanagh (2004/0054826) *supra* and Bedell et al. (hereinafter Bedell), United States Patent number 3,560,964.

Regarding claim 27, Kavanagh teaches all the limitations of claim 27 except that, (i) said RUI comprises a book of overlays having graphical indicia representing user input selections, and (ii) said apparatus further comprises a page identification sensor disposed in electronic communication with said controller. However, Bedell

teaches a multiple page keyboard input overlay device (see column 1 lines 52-55; "*The selected book is placed on a keyboard, as an overlay, preferably with the keys extending through the pages*") that has a page identification sensor disposed in electronic communication with said controller (see Abstract; "*The function of a given key is determined both by the book which is in place on the keyboard, and by the page to which that book is opened. This is accomplished by an arrangement of switch means which senses both the identity of the 20 book and the page to which the book is opened*"). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the keyboard overlays of Bedell with the removable user interface apparatus of Kavanagh to provide alternate methods of input.

Regarding claim 28, Bedell teaches that said book comprises a page identifier (see Abstract; "*...an arrangement of switch means which senses both the identity of the 20 book and the page to which the book is opened*").

Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen Alvesteffer whose telephone number is (571) 270-1295. The examiner can normally be reached on Monday-Friday 9:30AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Cabeca can be reached on (571)272-4048. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Stephen Alvesteffer
Examiner
Art Unit 2173



st
6-21-2007



TADESSE HAILU
PRIMARY EXAMINER